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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: David A. Morgenstern, et al.
Art Unit: 1625
Serial No.: 09/832,541
Filed: April 11, 2001
Confirmation No.: 3285
For: PROCESS AND CATALYST FOR DEHYDROGENATING
PRIMARY ALCOHOLS TO MAKE CARBOXYLIC ACID
SALTS
Examiner: Taylor V. Oh

December 16, 2002

RESPONSE TO RESTRICTION

TO THE ASSISTANT COMMISSIONER FOR PATENTS,
SIR:

In response to the Office action dated November 20, 2002,
please enter the following remarks:

Restriction Requirement

The Office action sets forth a restriction requirement under 35 U.S.C. § 121 to the following groups of claims: Group I (Claims 1, 15-18, 23-31, 46-49, 60-66, 74-76, 93 and 98-101); Group II (Claims 2-14, 19-22, 32-45, 50-59, 67-73, 78-81, 94-97 and 140-168); Group III (Claims 77 and 82-92); Group IV (Claims 102-126); Group V (Claims 127-138); and Group VI (Claim 139). For the reasons set forth below, Applicants hereby request reconsideration of the restriction requirement between the claims of Groups I, II and III and request rejoinder of Claims 1-101. Please note, however, that no traversal is being made as to the restriction between the claims of Groups IV, V and VI.

Groups I, II and III

Claims 1, 15-18, 23-31, 46-49, 60-66, 74-76, 93 and 98-101, which the Examiner has restricted to Group I, are directed to a process for the preparation of a carboxylic acid salt by

dehydrogenating a primary alcohol in the presence of a dehydrogenation catalyst comprising a copper-containing active phase at the surface thereof. Claims 2-14, 19-22, 32-45, 50-59, 67-73, 78-81 and 94-97, which have been restricted to Group II, are also directed to a process for dehydrogenating a primary alcohol in the presence of a dehydrogenation catalyst comprising a copper-containing active phase, and not to a dehydrogenation catalyst and its support system as purported in the Office action. In fact, each of the claims of Group II depend from claims of Group I and simply further define the claimed process with respect to the dehydrogenation catalyst employed.

Therefore, it is respectfully submitted that the claims of Group I and Group II are neither independent nor distinct such that restriction under 35 U.S.C. §121 is not proper. Thus, Applicants respectfully submit that restriction between the claims of Group I and Group II is traversed. Rejoinder of claims 1-76, 78-81 and 93-101 is hereby respectfully requested.

The claims of Group III, which include independent claim 77 and claims 82-92 dependent therefrom, are directed to a process for preparing disodium iminodiacetic acid by catalytically dehydrogenating diethanolamine in the presence of a dehydrogenation catalyst comprising a copper-containing active phase. However, it is respectfully submitted that the claims of Group III merely define a species within the generic claims defined in Groups I and II directed to a process for the dehydrogenation of a primary alcohol to make a carboxylic acid salt. That is, in claim 77, the carboxylic acid salt of claim 1 is disodium iminodiacetic acid and the primary alcohol of claim 1 is diethanolamine (see claim 29 of Group I). Thus, any search of the subject matter of Groups I and II directed to a process for the catalytic dehydrogenation of a primary alcohol would necessarily encompass the scope of the claims of Group III directed to the dehydrogenation of diethanolamine. Therefore, Applicants respectfully submit that examining the subject matter

of the claims of Group III with that of Groups I and II would not present an unreasonable burden on the Examiner. Reconsideration of the restriction and rejoinder of claims 1-101 is hereby respectfully requested.

Claims 140-168

It is important to note that claims 140-168, which are included in Group II for purposes of the restriction, are dependent claims which modify independent claim 139. Independent claim 139, which is directed to a process for making N-(phosphonomethyl)glycine, is restricted to Group VI. Thus, it is respectfully submitted that claims 140-168 appropriately fall within the scope of Group VI rather than the rejoined claims of Groups I, II and III (claims 1-101). Applicants are not making any traversal of the restriction with respect to Group VI at this time other than to request the joinder of claims 140-168 with claim 139.

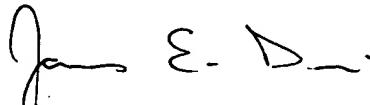
Provisional Election

For the reasons stated above, Applicants respectfully submit that the restriction between the claims of Groups I, II and III, (claims 1-101) should be withdrawn. However, so as to be fully compliant with 37 CFR 1.143, Applicants hereby make a provisional election, with traverse, of the claims of Group I, claims 1, 15-18, 23-31, 46-49, 60-66, 74-76, 93 and 98-101.

Conclusion

It is not believed that any fee is required by the timely submission of this Response to Restriction. However, the Office is hereby authorized to charge any underpayment or credit any overpayment of fees to Deposit Account No. 19-1345.

Respectfully submitted,



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